

### **REMARKS/ARGUMENTS**

Claims 4-7 are pending in the present application and are all presently rejected. New claim 7 has been added in this response. No new matter has been introduced. Applicants request reconsideration of the rejections in light of the following remarks.

Claims 4-6 of were rejected under 35 U.S.C. §103(a) as being unpatentable over *Rogers* (U.S. Pat. No. 5,617,471) in view of *Shaffer* (U.S. Pat. No. 5,825,858). The Applicants respectfully traverse this rejection for the following reasons.

Concerning independent claim 4, the prior art, alone or in combination, fails to teach the claimed element of “initiating setup, via the telecommunications switching office, and after reception of a request originating from the one of the further subscriber line and the operator’s position, of a new direct telecommunications connection between the two subscriber lines wherein the telecommunications switching office requests one of two further telecommunications switching offices to which the two subscriber lines are respectively connected to set up the new telecommunications connection.”

The cited art does not disclose a new direct telecommunications connection between the two subscriber lines wherein the telecommunications switching office requests one of two further telecommunications switching offices to which the two subscriber lines are respectively connected to set up the new telecommunications connection. In the Response to Arguments, the Office Action notes, without further explanation, that switch A in *Rogers* “is actually an ‘operator’ that actually determines how to bridge the call.” The remainder of the response focuses entirely on the teaching of *Shaffer*. These arguments were essentially repeated in the Advisory Action as well. Applicants respectfully submit that these responses do not address any of the arguments put forth in the aforementioned response.

Regarding switch A, *Rogers* teaches the following:

User-A 2 initiates the call transfer by notifying switch-A 6 of the transfer request. Both independent calls, i.e., call legs A-B 3 and A-C 5, are identified as part of the transfer. Switch-A 6 sends a request message 9 to NCS 20 requesting the set-up of communication between user-B 8 and user-C 14. A processor 24 accesses a database 22, located in NCS 20, to determine whether the requested transfer is allowed. NCS 20 then returns a response message 11 to switch-A 6 responding to the request message 9.

If the transfer is allowed, switch-A 6 connects user-B 8 with user-C 14 setting up call leg B-C 7, as shown in FIG. 2. Switch-A 6 also disconnects user-A's CPE 4 and user-A 2 from the conversation, as shown in FIG. 2. If the transfer is not allowed, switch-A 6, having received the response message 11 which disallows the transfer, notifies user-A 2 via CPE 4 of the denied request to transfer the call.

(col. 3, lines38-53). Again, *Rogers* is only teaching the setup of a connection between a CPE and a switch, such as a connection between user A and switch A. Under all the embodiments disclosed in *Rogers*, a call between the two connected users always remains connected only to switch A, and does not involve other respective switches as required in the present claims. Accordingly, a new connection is not established in the manner recited in the claims (i.e., "requests one of two further telecommunications switching offices to which the two subscriber lines are respectively connected to set up the new telecommunications connection"). Analogizing the system of *Rogers* to the claimed features of claim 4, a call transfer from the user B to the user C would require that a connection from the user B would be set up via the switch B and the switch C to user C; i.e, without the use of switch A. This, however, is not the teaching or suggestion of *Rogers*. Nor is this element taught or suggested by *Shaffer*, which relies on a conference bridge for its functionality. Thus, this element is simply not met by the cited references, either combined or taken separately. For this reason alone, Applicants submit that the rejection is improper and should be withdrawn.

In response to the question posed in the Advisory Action regarding Applicant's submission of *Rogers* in the 1449 document, Applicants note that the *Rogers* reference was cited as being relevant to the present claims. Because a reference is deemed relevant does not mean that it teaches or suggests the claimed limitations, as discussed above. *Rogers* describes a normal call transfer, using a network control system where caller A places 2 calls to the participants B and C, whereby both can be signing off and arriving. Caller A can transfer, via a message to the Switching network to have switch A obtain confirmation of the NCS in cases where callers B and C are connected. As a result, caller A is released, while callers B and C remain connected via switch A.

Furthermore, there is no teaching, suggestion or motivation to combine the references in the manner suggested in the Office Action. The mere fact that references can be combined or

modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (MPEP 2143.01). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (MPEP 2143).

It has been conceded that *Rogers* does not teach or suggest the claimed feature of "set[ting] up the new telecommunications connection in accordance with a selection which is made as a function of a tariff model which forms a basis of a billing system." In *Rogers*, a billing system is already disclosed, where a network call identifier uniquely identifies the call which is currently active or completed. Call detail records appear for call legs A-B 3, A-C 5, and B-C 7 on the customers' reports that accompany the invoices, so that the customers can readily identify the transferred calls (col. 7, line 65 – col. 8, line 24). In contrast, *Shaffer* relies on a unique conference bridge, utilizing a conference bridge manager that interfaces with the user interface, a connectivity computation component and a message interface component to tie in remote conference bridges (col. 4, lines 5-13; 30-39). As *Rogers* already provides for its own automated billing mechanism, there is no conceivable teaching, suggestion or motivation, other than one that was improperly gleaned from Applicant's disclosure, why one skilled in the art would turn to *Shaffer* to incorporate the conference bridge disclosed therein. This also was not addressed in the Final Office Action nor in the Advisory Action. While *Shaffer* discloses "optimal" routing for nodes within a conference bridge, *Shaffer* does not disclose the features discussed above, and no teaching suggestion or motivation was provided in the Final Office Action, other than "automating teleconferencing" while "saving money." As *Rogers* already provides automated call-transfer with an integrated billing system, there is no teaching to combine the references in the manner suggested in the office action. With regard to the Response to Arguments 2(b), the comment regarding switches A-C and *Shaffer* do not coincide, since it is *Rogers* that the Office Action relied upon for this feature, and not *Shaffer*. As such, it

is respectfully submitted that the rejection under 35 U.S.C. §103 is improper and should be withdrawn.

Concerning dependent claims 5 and 6, these claims are believed allowable on their merits and also on their dependency on claim 4.

In light of the above, the Applicants respectfully submit that claims 4-7 of the present application are patentable over the art of record. Therefore, Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

BELL, BOYD & LLOYD LLC

BY 

Peter Zura

Reg. No. 48,196

Customer No.: 29177

(312) 807-4208

Dated: August 15, 2005